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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Paper No. 13

Serial Number: 07/337,253  
Filing Date: 04/13/89  
Appellant(s): Don a. Perry

91-2492  
Bateman  
For Appellant

MAILED

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GROUP 330

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed  
February 6, 1991.

(1) *Status of claims.*

The statement of the status of claims contained in the brief  
is correct.

(2) *Status of Amendments After Final.*

The appellant's statement of the status of amendments after  
final rejection contained in the brief is correct.

(3) *Summary of invention.*

The summary of invention contained in the brief is correct.

(4) *Issues.*

The appellant's statement of the issues in the brief is  
substantially correct. The changes are as follows: The first  
issue is not just whether the declaration is defective because

Serial No. 337,253

-2-

Art Unit 338

the discovery of the error was made as a result of commercial activity which occurred after the original patent had issued, but rather whether language in claims in the original application which would have covered this embodiment but was specifically cancelled from the claims in the original application in order to read over the prior art can be recaptured, as Appellants attempt to do here.

Additionally, the third issue listed by Appellants is petitionable rather than appealable.

Appellant's brief presents arguments relating to whether or not additional drawing is required to illustrate the second claimed embodiment of the invention. This issue relates to petitionable subject matter under 37 C.F.R. § 1.181 and not to appealable subject matter. See M.P.E.P. §§ 1002 and 1201.

(5) *Grouping of claims.*

The rejection of claims 1-12 ~~stand or fall~~ stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together. See 37 C.F.R. § 1.192(c)(5).

(6) *Claims appealed.*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(7) *Prior Art of record.*

2,694,396

PASCHAL ✓

11-1954

Serial No. 337,253

-3-

Art Unit 338

645,391

BECK (Germany) ✓

5-1937

(8) *New prior art.*

No new prior art has been applied in this examiner's answer.

(9) *Grounds of rejection.*

The following ground(s) of rejection are applicable to the appealed claims.

The reissue declaration filed with this application is defective because it states that the discovery of the error was caused by the development of a new embodiment after the patent had issued. The purpose of a Reissue Application is to correct errors that occur during prosecution, not to cover newly developed embodiments which would have been covered by claims in the original application, which coverage had been intentionally cancelled in order to read over the prior art.

Claims 1-12 stand rejected as being based upon a defective reissue declaration under 35 U.S.C. 251. See 37 C.F.R. 1.175.

Claim 12 stands rejected under 35 U.S.C. 103 as being unpatentable over Paschal in view of Beck.

Paschal discloses everything claimed with the possible exception of the properties of the elastic material. Paschal does state that his enclosure can be made from "flexible plastic material or any other suitable flexible material which is impervious to liquid". Beck teaches the use of rubber as the elastic material for a lubricant filled massaging device similar

Serial No. 337,253

-4-

Art Unit 338

to the type disclosed by Paschal. In view of the teachings of paschal and Beck it would have been obvious to one of ordinary skill in the art to use rubber for the elastic material of Paschal because of its known suitability for such a use. To select any particular rubber known at the time of Appellants' invention based on its known properties, including one meeting the property limitations claimed in claim 12 would have been an obvious matter of design choice at the time of Applicants' invention.

(10) *New ground of rejection.*

This Examiner's Answer does not contain any new ground of rejection.

(11) *Response to argument.*

The case law cited in Appellants' arguments to support the propriety of the reissue declaration is not persuasive because these cases address different issues than those at hand in this application. In the Wilder case the claims were narrower than the prior art required. As evidenced by the fact that in Applicants' parent case to this application the claims were amended to limit the scope of the claim to a single piece of material, from no specifics regarding the number of pieces, in order to read over the art, those claims were not narrower than the prior art required. In addition, the closest prior art has two pieces. As to the Wadlinger case, this reissue recognized an

inherent capability of the previously claimed structure, not a new, alternative embodiment as Appellants are trying to claim in the current application.

While it is critical that the error occurred with no deceptive intent, in a Reissue it is also critical that the error occurred during prosecution.

As to Appellants' citation of the In re Wright and In re Dillon decisions, the Federal Circuit has accepted a suggestion for rehearing in banc filed on behalf of the Commissioner (Appeal No. 88-1245 Fed. Cir.) and has vacated the panel decision in In re Dillon. Hence, the Dillon opinion published in the Federal Reporter, Second Series, and the USPQ, Second Series, is no longer precedent. Because the suggestion for rehearing in banc also questions the correctness of In re Wright, until a final decision is rendered in Dillon, the Wright decision is not considered binding.

Regarding arguments drawn to the rejections based on art, the issue is not whether use of the materials disclosed by Applicants would have been obvious to one of ordinary skill in the art at the time of invention of Paschal's or Beck's devices, but rather whether it would have been obvious to one of ordinary skill in the art at the time of the invention claimed in the present application. As these materials and their properties were known, and not invented by Applicants, to select them for

Serial No. 337,253

-6-

Art Unit 338

their properties, which meet the guidelines of Paschal, being flexible and impervious to liquid, would have been obvious to one of ordinary skill at the time of Applicants' invention. For this reasons the affidavits by Professor Ichniowski on what materials existed in the 1930's and 1950's are not persuasive as to the art rejections.

The affidavit of Wright is drawn only to secondary considerations. When there is a solid rejection based on art, secondary considerations do not make the claims allowable. The evidence relating to the secondary considerations provided by Appellants does not overcome the prima facie case of obviousness presented in the above obviousness rejection.

What claim language was allowed by foreign patent offices has no bearing on what is considered allowable under the U.S. Patent Laws. Laws governing granting of patents vary greatly from one country to another.

Appellants' arguments drawn to the drawing objections have not been addressed as this is a petitionable matter, not a matter for decision by the Board of Appeals.

#### CONCLUSION

It is the Examiner's firm opinion that the appealed claims are not patentable for the reasons set forth above. It is submitted that Appellants have presented no convincing argument

Serial No. 337,253

-7-

Art Unit 338

as to why the above rejections are improper and affirmance is respectfully requested.

Respectfully Submitted,

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March 14, 1991  
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